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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,499	06/14/2002	Matthias Hessling	10191/2152	6405
26646 7590 03/20/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
NGUYEN, CINDY				
ART UNIT		PAPER NUMBER		
2161				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/031,499

Applicant(s)

HESSLING ET AL.

Examiner

CINDY NGUYEN

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

This is response to communication filed 12/22/08.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19-37 provisionally rejected on the ground of nonstatutory double patenting over claims 25 and 34 of copending Application No. 10/540419. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: instant application and copending application have the same subject matter such as encoding, decoding and transmitting of a data packet containing location information of at least one object for a map by one an encoder, decoder and transmitter/receiver, the location information of at least one object including locating information, wherein the data packet separately contains the locating information and the description information, and includes assignment for assigning at least a part of the locating information to at least a part of the description information.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-25, 27 and 28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 19, 30, recited "a method for at least on of electronically encoding, decoding and transmitting ...". However, these method/processes fail to : (1)

ties to another statutory class (such as a particular apparatus) and (2) transform underlying subject matter (such as an article or materials) to a different state or thing (In re Bilski, 88 USPQ2d 1385 (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parkerv. Flook, 437 U.S. 584,588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). Therefore, the methods recited in claims 19 and 30 are not patentable eligible processes under 35 USC § 101 since they are directed to non-statutory subject matter

Regarding claim 36, "a system" is recited, however, "a system" would reasonably be interpreted to be of ordinary skill in the art as software per se. (see specification, paragraphs 0027, 0030, 0032). (See MPEP 2106).

Claims 20-29 and 37, full incorporating the deficiencies of their parent claim, are likewise rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Israni et al. US 6438561, hereafter Israni.

Regarding claims 19, 30, 31, 33 and 36, Israni discloses: A method for at least one electronically of encoding, decoding and transmitting location information, the method comprising:

at least one of encoding, decoding and transmitting of a data packet (see col. 4, line 66 to col. 5, line 13, Israni) containing location information of at least one object for a map by one an encoder, decoder and transmitter/receiver, the location information of at least one object including locating information (data packet is interpreted as traffic message see col. 5, lines 15-60, Israni), wherein the data packet separately contains the locating information (col. 5, lines 33-35, Israni) and the description information (see col. 5, lines 28-31 Israni), and includes assignment for assigning at least a part of the locating information to at least a part of the description information (see col. 5, lines 54-60; col. 13, lines 35-45; col. 14, lines 5-11, Israni).

Regarding claim 20, all the limitations of this claim have been noted in the rejection of claim 19 above. In addition, Israni disclose: wherein the locating information includes at least one first coordinate chain that includes at least one first point (see col. 8, lines 15-18, Israni).

Regarding claim 21, all the limitations of this claim have been noted in the rejection of claim 20 above. In addition, Israni discloses: wherein the at least one first coordinate chain contains a second point, the at least one first point of the at least one first coordinate chain is specified in absolute coordinates and the second point of the at least one first coordinate chain is specified in relative coordinates, with respect to one of a centroid coordinate and the at least one first point of the at least one first coordinate chain (see col. 8, lines 34-52, Israni).

Regarding claim 22, all the limitations of this claim have been noted in the rejection of claim 21 above. In addition, Israni discloses: wherein the at least one first point of the at least one first coordinate chain is interpreted in a defined direction by the second point of the at least one first coordinate chain (col. 9, lines 15-32, Israni).

Regarding claim 23, all the limitations of this claim have been noted in the rejection of claim 19 above. In addition, Israni discloses: wherein the description information includes at least one first attribute field (col. 9, lines 15-25, Israni).

Regarding claim 24, all the limitations of this claim have been noted in the rejection of claim 23 above. In addition, Israni discloses: wherein the at least one first attribute field includes a type specification and description data, and the description data is determined by the type specification with respect to at least one of a name, an accuracy, a direction, a time, a point of interest and a physical link (col. 9, lines 50 to col. 10, lines 17, Israni).

Regarding claim 25, all the limitations of this claim have been noted in the rejection of claim 23 above. In addition, Israni discloses: wherein the assignment information includes at least one first assignment entry and the at least one first attribute field and the at least one first

point of the at least one first coordinate chain are assigned to each other by the at least one first assignment entry (col. 9, lines 8-25, Israni).

Regarding claim 26, all the limitations of this claim have been noted in the rejection of claim 25 above. In addition, Israni discloses: wherein the at least one first assignment entry includes a reference to the at least one first attribute field and a reference to the at least one first point of the at least one first coordinate chain (col. 9, lines 25-33, Israni).

Regarding claim 27, all the limitations of this claim have been noted in the rejection of claim 25 above. In addition, Israni discloses: wherein the at least one first assignment entry includes one of (i) a reference to the at least one first attribute field and a reference to a plurality of points of coordinate chains of the locating information, and (ii) a reference to a plurality of attribute fields and a reference to the at least one first point of the at least one first coordinate chain (col. 9, lines 8-33, Israni).

Regarding claim 28, all the limitations of this claim have been noted in the rejection of claim 19 above. In addition, Foust discloses: wherein the data packet includes a header part of the location information and a data part of the location information (col. 12, 35-50, Israni).

Regarding claim 29, all the limitations of this claim have been noted in the rejection of claim 28 above. In addition, Foust discloses: wherein the header part includes structure information specifying a data structure of the location information, and includes interpreting instructions specifying a purpose of the location information (col. 5, lines 45-60, Israni).

Regarding claim 32, all the limitations of this claim have been noted in the rejection of claims 31 and 20 above. In addition, Israni discloses: wherein a definition of the at least one

first point of the at least one first coordinate chain is definable as a function of location information query (col. 26, lines 15-30, Israni).

Regarding claim 34, all the limitations of this claim have been noted in the rejection of claim 33 above. In addition, Israni discloses: wherein the location information is at least partially correlatable with data of a first database associated with the decoding device (col. 6, lines 38-50, Israni).

Regarding claim 35, all the limitations of this claim have been noted in the rejection of claim 34 above. In addition, Israni discloses: wherein at least one of location information that is not contained in the first database and location information is not correlated with data of the first database is stored in a second database associated with the decoding device (col. 10, lines 18-24, Israni)

Regarding claim 37, all the limitations of this claim have been noted in the rejection of claim 20 above. In addition, Israni discloses: wherein the at least one first point includes a geographical point (col. 8, line 32-52, Israni)

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. N./

Examiner, Art Unit 2161

/Apu M Mofiz/

Supervisory Patent Examiner, Art Unit 2161